

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS

In re: The Application of:

INVENTOR(S): Rodger Burrows

GROUP ART UNIT: 3622

SERIAL No.: 09/910,654

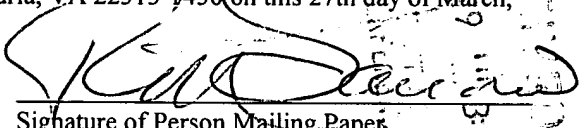
EXAMINER: Duran, Arthur D

FILING DATE: 7/20/01

TITLE: METHODS AND APPARATUS FOR ELECTRONICALLY STORING
TRAVEL AGENT COUPONS

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TRANSMITTAL LETTER

Transmitted herewith for filing in the above referenced application and appeal are:

Applicant Rodger Burrows Response Brief on Appeal in triplicate.
Post card

The Commissioner is hereby authorized to charge the above fees and any additional fees to
Deposit Account No. 19-0010.


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IN THE U.S. PATENT OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

RESPONSE BRIEF OF
APPELLANT RODGER BURROWS
UNDER 37 C.F.R 1.191

IN RE: The Application of:

INVENTOR: Rodger Burrows

GROUP ART UNIT: 3622

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EXAMINER: Duran, Arthur D

FILING DATE: 7/20/01

TITLE: METHODS AND APPARATUS FOR ELECTRONICALLY
STORING TRAVEL AGENT COUPONS

March 27, 2006

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GROUP 3600

**RESPONSE BRIEF OF
APPELLANT RODGER BURROWS
UNDER 37 C.F.R 1.191**

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The following brief is hereby submitted in response to the Examiner's Answer

The Examiner's Answer stated that "The appellant's statement of the grounds of rejection to be reviewed on appeal is correct." For purposes of convenience, the issue is restated below.

ISSUE NO. 1

Whether the Examiner's rejection of claims 1-15 and 17-18 under 35 U.S.C. 103(a) is proper on the basis that "although ARC in its entirety seems to suggest an optical storage of image data, the artisan would have found it obvious to also store the image data in electronic form for subsequent reconstruction as an image.", notwithstanding the new evidence and argument submitted by Applicant in his Request to Reopen Prosecution and Response of March 25, 2005.

RESPONSE ARGUMENT

An argument is presented to the Examiner's Answer as it concerns Appellant's arguments in his Brief of November 21, 2005.

Introduction

The Examiner's Answer may be considered as being in two parts: 1) Grounds of Rejection, and 2) Response to Argument. Appellant will address the "two parts" to the extent that new arguments are made.

I Examiner's Ground Of Rejection

The Examiner quoted Applicant's previous quotes of ARC in the 2000 and the 2005 IAH wherein it was stated that "However, computer hard drives, zip drives, floppy disks, magnet tape, and other magnetic media are NOT acceptable." The Examiner then reasoned that this passage clearly discloses that alternative means for storing the supporting documents were not only known at the time, but also, considered by ARC. Ostensibly then, the Examiner is of the belief or opinion that such storage of the coupon data by Appellant's invention is in accordance with the "alternative means for storing the supporting documents" and therefore is obvious under 35 U.S.C. § 103.

Respectfully, the Examiner is mixing apples with oranges. The ARC statement immediately prior to the quoted sentence states "...all supporting documents must be copied to microfiche film or to a non-magnetic optical medium..." The key word is "copied"; storing is not an alternative to copying as those words were used by the Examiner. Copying requires the presence of a physical document. Thus, ARC's

verbiage can only be interpreted as meaning the physical agent coupon, which can be considered as a document, must be copied to an optical medium that cannot be overwritten, and not copied to for example to a hard drive. Certainly, it was known to scan a document or an agent coupon, thereby creating a copy and then storing the copy to a hard drive. But, the same is not Appellant's invention. Appellant's invention does not involve creating a copy of an image and then storing the same. Appellant's invention involves the unique capturing, creation and storing of alphanumeric coupon data and then programmatically constructing and transmitting it in a form that allows creation of an actual image of the coupon from the stored data. The data can then be retrieved and vied on a computer screen as an image facsimile with the option of creating a paper print out. Again, copying is not involved in Appellant's invention. Hence, it is not possible for the verbiage of ARC relied on by the Examiner to render obvious Appellant's invention; apples are not oranges.

II Examiner's Response To Appellant's Argument

In Appellant's brief, great effort was made to point out the inappropriate combining of the words "image" and "data" by the BPAI decision of January 25, 2005 and the resulting mis-interpretation of Appellant's invention caused thereby. However, the Examiner answers that the BPAI had already recognized and rejected Appellant's argument in this regard. This is not so. The new ground of rejection by the BPAI continuously combined "image data" and "coupon image data". It is to be remembered that Appellant's argument in opposition to the new ground of rejection was in part as follows:

In the final rejection of May 24, 2005, and responding to Applicant's argument in the request to reopen prosecution, the Examiner essentially adopted the Board's new ground of rejection in its decision of January 1, 2005, (that is that "...although ARC in its entirety seems to suggest an optical storage of **image data**, an artisan would have found it obvious to also store the **image data** in electronic form for subsequent

reconstruction of the image.”(emphasis supplied), Office Action of May 24, 2005. page 3, lines 8-10. The Board’s decision (and now, the Examiner’s decision) was based on prior art comprising transmissions over a communications channel such as a facsimile transmission or a multimedia network transmission.

Appellant then went on to show that a facsimile transmission or a multimedia network transmission do not transmit data which is then reconstructed as an image but rather transmitted an image. Thus, the BPAI, the final rejection of May 25, 2005, and the Examiner’s present Answer have not considered and rejected Appellant’s argument.

In further support of the argument on obviousness, the Examiner’ Answer quotes a part of the IAH of 2000 and 2005 beginning with “maintain the required documents on microfiche film...” It is submitted that this part of the ARC quote is taken out of context and therefore does not further support the obviousness rejection. The introduction to the out of context quote always was with reference to “copying” the documents thereby creating an optical image. Again, this is not Appellant’s invention.

Finally, the Examiner’s Answer attempts to show that Appellant’s own specification discloses that data can use an image format. This attempt is misplaced. Appellant’s specification, when read in its entirety, disclose that the uniquely generated coupon data can be transmitted in various formats that in and of themselves do not transmit an optical image but rather a data format consisting solely of alphanumeric characters that in accordance with the invention can be stored so as to be later reconstructed as an actual image facsimile.

It is submitted that Examiner’ Answer argument based on *In re Van Geuns* 988 F.2d 1181 (Fed. Cir. 1993) and *In re Hyatt*, 211 F.3d 1367(Fed. Cir. 2000) raise new arguments for the first time and is inappropriate. However, even if the newly added

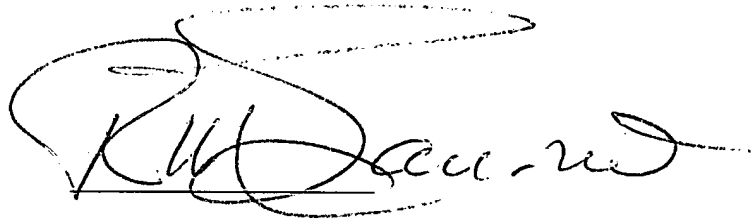
argument is stricken, the damage is already done because of the inability to actually erase the argument from one's mind-either conscious or subconscious.

The Examiner's Answer rejecting Appellant's arguments vis a vis Appellant's invention uses a different method disclosed by Arc, and that ARC teaches away from Appellant's claimed invention are without support or legal foundation in that the Answer does not acknowledge that ARC's disclosure is only with regard to copying thereby creating an optical image.

IV CONCLUSION

The Examiner's Answer does not substantiate or legally support the obviousness rejection of Appellant's claimed invention.

Dated March 27, 2006

A handwritten signature in black ink, appearing to read 'R. M. Saccocio', with a large, stylized flourish above the name.

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